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STRAUB & POKOTYLO 1 Bethany Road Suite 56 Building 4 Hazlet, NJ 07730			EXAMINER SAVAGE, MATTHEW O	
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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Paper No. 022004

Application Number: 09/400,034
Filing Date: September 21, 1999
Appellant(s): ITO, RALPH K.

John Pokotylo
For Appellant

EXAMINER'S ANSWER

MAILED

FEB 26 2004

GROUP 1700

This is in response to the appeal brief filed 12-5-03.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

No amendment after final has been filed.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 1-10 and 53-63 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

US 6,432,366 Ruediger et al 8-2002

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-10 and 53-63 are rejected under 35 U.S.C. 102(e) as being anticipated by Ruediger et al.

With respect to claim 1, Ruediger et al disclose a first part including a pipette tip 54 having an open tip end, a sample cup 10, 56 fluidly coupled with the pipette tip and having an open end, and a second part including a channel (e.g., defined by parts 40 44) for receiving the pipette tip of the first part, a support (e.g., defined by part 39) for accommodating at least a portion of the sample cup, and a constricted passage (e.g., defined by parts 62 and 68) arranged between the channel and support and being capable of collapsing the pipette tip as the first part is inserted into the second part in any of three modes as follows: 1) collapsing part 54 between parts 62 and 68 after it has been fully received within parts 39, 40, and 44 as shown in FIG. 8; 2) partially inserting part 54 into parts 39, 40, and 44, collapsing the tube between parts 62 and 68, and then fully axially inserting part 54 into parts 39, 40, and 44; partially or fully closing the gap between parts 62 and 68 with the screw operated adjustment mechanism 42 shown in FIG. 1 followed by fully axially inserting part 54 into parts 39, 40, and 44.

Concerning claims 2-3, Ruediger et al disclose the pipette as being formed of a flexible and collapsible material (see FIG. 8).

Regarding claim 4, Ruediger et al discloses an arrangement capable as functioning as recited in the claim (see modes 2 and 3 listed above).

As to claim 5, Ruediger et al disclose the length of the channel as being at least as long as a length of the pipette tip (see FIG. 13).

Concerning claim 6, Ruediger et al disclose the sample cup 56 as being dimensioned to mate with a suitable automated pipette system (e.g., one having exterior diameter equal that of the inside diameter of the cup.

Regarding claim 7, Ruediger et al disclose a support 39, 44 shaped to match a bottom of the sample cup.

Concerning claim 8, Ruediger et al disclose the support 39, 44 of the second part as being shaped to guide the pipette tip of the first part to the constricted passage as the first part is inserted into the second part.

As to claim 9, Ruediger et al disclose the support 44 as being shaped as a funnel.

Regarding claim 10, Ruediger et al disclose the support as being tapered.

As to claim 53, Ruediger et al disclose a pipette tip that is tapered (see the tapered portion part 56).

Regarding claim 54, Ruediger et al disclose a constricted passage with a fixed cross section (e.g., once the position of slide 44 carrying tube 68 defining one side of the constricted passage has been set as described on lines 11-55 of col. 10).

Ruediger et al discloses an apparatus capable of functioning as recited in claims 55-63 when operated in modes 2-3 listed above.

(11) Response to Argument

Response to applicant's arguments against the rejections under 35 U.S.C. 102(e) in view of Ruediger et al of Group I, claims 1, 2, 3, and 5-8.

Applicant argues that Ruediger et al fail to disclose a constricted passage arranged between a channel and a support for collapsing a pipette tip of a first part as the first part is inserted into the second part as recited in claim 1, however, it is held that the reference discloses a constricted passage between parts 62 and 68 (see FIG. 8) arranged between a channel defined by part 40 and a support defined by parts 39 and 44 and being capable of collapsing the pipette tip as the first part is inserted into the second part in one of three modes: 1) collapsing part 54 between parts 62 and 68 to after it has been fully received within parts 39, 40, and 44 as shown in FIG. 8 and as disclosed from line 48 of col. 9 to line 55 of col. 10; 2) partially inserting part 54 into parts 39, 40, and 44, collapsing the tube between parts 62 and 68 to form a liquid seal, and then fully axially inserting part 54 into parts 39, 40, and 44; setting the gap between parts 62 and 68 to that required to normally collapse the tube followed by fully axially inserting part 54 into parts 39, 40, and 44.

Applicant argues that Ruediger et al fail to anticipate claim 1 in the case of mode 1 listed above since the reference discloses collapsing of the tube after it has been situated within the constricted passage, however, it is held that the functional limitation "for collapsing a pipette tip of a first part as the first part is inserted into the second part" of claim 1 is broad enough to include the procedure of collapsing the pipette tip after situating the pipette tip into a restricted passage having an adjustable cross section as disclosed by Ruediger et al since the word "as the first part is inserted into the second part" can be broadly interpreted as meaning "while the first part is inserted into the second part". Alternately, it is held that the sequence of events implied by the phrase "

as the first part is inserted into the second part" carries no patentable weight because it relates to the intended use of an apparatus having the same structure to the extent recited in instant claim 1.

Applicant argues that Ruediger et al fail to anticipate claim 1 in the case of modes 2 and 3 since the modes are unsubstantiated and not inherent. While it is noted that Ruediger et al fail to explicitly disclose modes 2-3, it is held that the apparatus disclosed by Ruediger is inherently capable of functioning in modes 2-3 for the reasons as follows: a) the pipette tip 54 has sufficient length to be axially inserted through the constricted passage formed by parts 62 and 68 to force any liquid contained therein upwardly and into the sample cup 56 in the same manner as disclosed by applicant; b) the constricted passage would permit insertion of pipette through the passage since the pipette is clamped between parts 62 and 68 without crushing or permanently distorting the pipette (see lines 11-22 of col. 10); c) the Teflon covered member 68 of the restricted passage would provide a curved low friction surface facilitating insertion of the pipette tip.

Applicant argues that Ruediger et al fail to anticipate claim 1 in view of Clough v. Gilbert & Baker Mfg. since adjustment of the device is necessary, and in view of Topliff v. Topliff since modification of the device is required, however, it is held that the reference anticipates the claim since no adjustment or modification of the device would be required other than that normally required to collapse the tube as disclosed by Ruediger et al.

Applicant argues that the rejection of claim 1 over Ruediger et al is improper since "Inherency may not be established by probabilities or possibilities" as set forth in In re Robertson, however, it is held that the rejection is proper since one skilled in the art would expect that the apparatus of Ruediger et al could operate in modes 2-3 above for reasons a)-c) listed above. It is further noted for the record that applicant has failed to provide any evidence that the apparatus of Ruediger et al could be not be operated in modes 2-3 listed above.

Applicant argues that modes 2-3 set forth above are irrelevant in view of Transclean Corp V. Bridgewood Services Inc., however, the case law is not considered applicable because the device disclosed by Ruedinger et al is inherently capable of functioning in modes 2-3.

Response to applicant's arguments against the rejections under 35 U.S.C. 102(e) in view of Ruediger et al of Group II, claim 4.

Applicant's argument that Ruediger et al fail to disclose the functional recitations of claim 4 is noted, however, it is held that the device of Ruediger et al is inherently capable of functioning as recited in claim 4 since it can be operated in modes 2-3 as listed above for reasons a)-c) listed above.

Response to applicant's arguments against the rejections under 35 U.S.C. 102(e) in view of Ruediger et al of Group III, claims 9 and 10.

Applicant's argument that part 44 fails accommodate at least a portion of the sample cup 56 as recited in the claim 1 is noted, however, it is held that parts 39 and 44 together form a support that accommodates a portion of the sample cup with part 44 defining the funnel recited in claim 9 and that forms the tapered portion recited in claim 10.

Response to applicant's arguments against the rejections under 35 U.S.C. 102(e) in view of Ruediger et al of Group IV, claim 53.

Applicant argues that part 54 disclosed by Rudiger et al is not tapered, however, it is held that the pipette 54 is tapered since it includes a tapered portion between an upper larger diameter part receiving a lower end of part 56 and a lower smaller diameter part that is received within the constricted passage. Applicant's contention that part 56 is not the pipette is noted and agreed with. It is noted for the record that "56" should have read -54—in the of claim 53 of the final office action.

Response to applicant's arguments against the rejections under 35 U.S.C. 102(e) in view of Ruediger et al of Group V, claim 54.

Applicant argues that the apparatus of Ruediger et al does not include a constricted passage that has a fixed cross section as recited in instant claim 54, however, it is held that the constricted passage has a fixed cross section during the period of time when the pipette is being collapsed to form a liquid seal. Applicant argues that the constricted passage of Ruediger et al is temporary as opposed to being fixed,

however, it is held that the cross section of the constricted passage of Ruediger et al could maintained in a fixed position indefinitely in a case where it was desired to maintain a permanent liquid seal.

Response to applicant's arguments against the rejections under 35 U.S.C. 102(e) in view of Ruediger et al of Group VI, claims 55-57.

Applicants argument that Ruediger et al fail to disclose the limitations set forth in claims 55-57 is noted, however, it is held that the reference is inherently capable of functioning as recited in the claims in modes 2-3 for the reasons set forth in groups I and II listed above.

Response to applicant's arguments against the rejections under 35 U.S.C. 102(e) in view of Ruediger et al of Group VII, claims 58-60.

The rejection of claims 58-60 are maintained for the reasons applied to groups I, IV, and VI set forth above.

Response to applicant's arguments against the rejections under 35 U.S.C. 102(e) in view of Ruediger et al of Group VIII, claims 61-63.

The rejection of claims 58-60 are maintained for the reasons applied to groups I, V, and VI set forth above.

For the above reasons, it is believed that the rejections should be sustained.

Art Unit: 1723

Respectfully submitted,

Matthew O. Savage

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Primary Examiner

Art Unit 1723

mos

February 20, 2004

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